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FOLEY & LARDNER LLP P.O. BOX 80278 SAN DIEGO, CA 92138-0278				NGUYEN, TAN D
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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS

5 AND INTERFERENCES

6

7

8 *Ex parte* JULIE A. SCHWARTZ,
9 JAMES H. SCHWARTZ,
10 JEANE S. CHEN,
11 HARRY E. GRUBER, and
12 EPHRAIM FEIG

13

14

15 Appeal 2009-003994
16 Application 09/764,787
17 Technology Center 3600

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20 Decided: November 20, 2009

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23 Before HUBERT C. LORIN, LINDA E. HORNER, and
24 ANTON W. FETTING, *Administrative Patent Judges*.

25 FETTING, *Administrative Patent Judge*.

26

27 DECISION ON APPEAL

28

An oral hearing was held on October 22, 2009.

1 STATEMENT OF THE CASE

2 Julie A. Schwartz, James H. Schwartz, Jeane S. Chen, Harry E. Gruber,
3 and Ephraim Feig (Appellants) seek review under 35 U.S.C. § 134 (2002) of
4 a non-final rejection of claims 58-72, 75-94 and 97-107, the only claims
5 pending in the application on appeal. We have jurisdiction over the appeal
6 pursuant to 35 U.S.C. § 6(b) (2002).

7 SUMMARY OF DECISION¹

8 We AFFIRM and ENTER A NEW GROUND OF REJECTION
9 PURSUANT TO 37 C.F.R. § 41.50(b).

10 THE INVENTION

11 The Appellants invented a way for conducting an efficient fundraising
12 campaign over a wide area network, such as the Internet that increases the
13 efficiency of a fundraising campaign by providing a fast, convenient and
14 reliable means for conducting the campaign. (Specification 1:12-16).

15 An understanding of the invention can be derived from a reading of
16 exemplary claim 58, which is reproduced below [bracketed matter and some
17 paragraphing added].

¹ Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed March 23, 2007) and Reply Brief ("Reply Br.," filed December

1 58. A method for conducting a fundraising campaign by an
2 organization over a wide-area network, comprising the steps of:
3 [1] hosting a website including a plurality of linked web pages,
4 the website
5 providing information about the fundraising campaign
6 and
7 soliciting potential donors to make a charitable
8 contribution to the fundraising campaign;
9 [2] providing a link to a personal donation page
10 in one or more email messages to third parties,
11 the personal donation page having the name and personal
12 campaign goal of a solicitor registered on the website;
13 [3] receiving a charitable contribution
14 via the personal donation page from a donor;
15 [4] updating,
16 according to instructions from the donor,
17 one or more virtual plaques displayed on one or more
18 web pages
19 to recognize new donors;
20 [4] forming teams on the website,
21 to participate in the fundraising campaign
22 by soliciting donations by emails,
23 wherein the teams compete with each other to raise
24 money; and
25 [5] displaying team ranks on the virtual plaques.
26

10, 2007), and the Examiner's Non-Final Rejection ("Non-Final Rej.",
mailed July 6, 2006) and Answer ("Ans.," mailed October 9, 2007).

THE REJECTIONS²

2 The Examiner relies upon the following prior art:

Costin US 20020049816 A1 Apr. 25, 2002

3 McBrearty, B.R. "What's Ahead For Telemarketing", Fund Raising
4 Management, (December 1986), pp. 1, 4, 71-76.

5 Smith, G.E. "The impact of direct marketing appeals on charitable marketing
6 effectiveness", Journal of the Academy of Marketing Science, v24n3
7 (Summer 1996), pp. 1-18

⁸ Gale Group, BT: Sheryl Gascoigne and Anna Walker bring a touch of glamour to BT Swimathon '99", M2 Presswire, (Nov. 27, 1998), pp. 1-4

¹⁰ Leukaemia Busters Fundraising Week, 26th June - 4th July 1999, pp. 1

11 Claims 58-72, 75-81, 82-94, 97-101, 102, and 106-107 stand rejected
12 under 35 U.S.C. § 103(a) as unpatentable over Costin, McBrearty, Smith,
13 and Gale Group or Leukaemia Busters.³

14 Claims 58-72, 75-94, and 97-107 stand provisionally rejected under the
15 doctrine of obviousness-type double patenting.⁴

² The Appellants also argue a hypothetical rejection for alleged new matter. App. Br. 6:¶ II. The Examiner did not make a rejection under 35 U.S.C. § 112, first paragraph. The Examiner instead, objected to the entry of an amendment filed on December 16, 2005. Non-Final Rej. 2-3. Thus a rejection for new matter is not before us. Appeal as to an Examiner objection is by way of petition to the Director of the U.S. Patent and Trademark Office under 37 C.F.R. 1.181. *See* MPEP 1002.02(c)(4).

³ Claims 103-105 are also rejected under 35 U.S.C. § 103(a) (Non-Final Rej. 5-13) but these rejections are not appealed by the Appellants. Ans. 4.

⁴ This rejection entered at Non-Final Rej. 3 is not repeated in the Answer, presumably because the Appellants agreed to file a terminal disclaimer which would obviate the rejection at allowance. App. Br. 18.

1

ARGUMENTS

2

The Appellants contend that none of the references describe the personal web page as used in limitations [2] and [3]. App. Br. 9-10. The Appellants also present evidence of secondary considerations of non-obviousness.

5

ISSUES

6

The issue of whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 58-72, 75-81, 82-94, 97-101, 102, and 106-107 under 35 U.S.C. § 103(a) as unpatentable over Costin, McBrearty, Smith, and Gale Group or Leukaemia Busters turns on whether it was predictable to use a personal web page with Costin in view of the evidence of non-obviousness.

12

FACTS PERTINENT TO THE ISSUES

13

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

15

Facts Related to the Prior Art

16

Costin

17

01. Costin is directed to online marketing applications for e-businesses using a fundraising system that allows e-businesses to partner with causes, such as charitable, non-profit and community organizations, to host fundraising events online with interactive participation by all involved. Costin ¶ 0006.

02. Costin describes the advantages of its use of the internet and e-mail to raise money as creating a viral marketing campaign. Costing ¶ 0007.

03. Costin describes enabling customers, employees, and donors to become individual fund-raisers by setting up a personalized campaign page and sending e-mails to anyone they choose, including friends, family and colleagues. Costin ¶ 0010.

04. Costin describes providing e-mail recipients with a message identifying the person forwarding the email and a message explaining that person's association or experiences with the cause. The email message typically includes links to the campaign page, where the potential donor may learn about the event and make secure, credit card or other donations or contributions. Costin ¶ 0010.

05. Costin's email message may also include contact information or links to other sites, such as the e-business or sponsor web site, the cause's web site, the forwarding donor's web site or email address. In this hierarchy, the initial donor/fund-raiser who forwards the email may be referred to as the "primary" donor and the potential donor receiving the email as the "secondary" donor, and so forth and so on. Costin ¶ 0010.

06. Costin describes a process in which a fundraising service provider facilitates joining causes by having a sponsor host an online fundraising campaign associated with and for the benefit of a cause. A host sponsor maintains a web site and one or more web

1 pages at the sponsor site may be dedicated to a fundraising
2 campaign having an online component. Costin ¶ 0066.

3 07. Costin also describes implementing in a portal fashion, whereby
4 a particular sponsor provides its customers, such as students or
5 student-run organizations, with the ability to set up a fundraising
6 campaign. This system enables fund-raisers to create individual
7 dedicated fundraising campaign pages for particular organizations,
8 for instance, fraternities, athletic teams, etc. In this manner,
9 individual students or groups of students or the like may set up a
10 dedicated fundraising campaign to send email messages to
11 identified recipients to request donations or other assistance in
12 conjunction with a particular cause or event. Costin ¶ 0084.

13 *McBrearty*

14 08. McBrearty is directed to describing the use of telemarketing in
15 fund raising. One fund raising expert noted that personalization is
16 a key concept to develop a personal relationship with donors.
17 McBrearty: Abstract.

18 *Smith*

19 09. Smith is directed to charitable giving guidelines based on
20 behavioral research. Smith: Abstract.

21 10. Smith describes displaying a list of donors and the sizes of
22 others' donations as a visual anchor for affecting donor behavior.
23 Smith: Fifth page.

24

1 *Gale Group*

2 11. Gale Group is directed to describing the fund raising strategy
3 used by BT Swimathon '99. One aspect was the formation of
4 teams. Gale Group: First page.

5 *Leukaemia Busters*

6 12. The article Leukaemia Busters is directed to a fund raising
7 campaign and describes the use of teams in fund raising.
8 Leukaemia Busters: Left column.

9 *Facts Related To The Level Of Skill In The Art*

10 13. Neither the Examiner nor the Appellants have addressed the
11 level of ordinary skill in the pertinent arts of systems analysis and
12 programming, non-profit management, or fund raising. We will
13 therefore consider the cited prior art as representative of the level
14 of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d
15 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings
16 on the level of skill in the art does not give rise to reversible error
17 ‘where the prior art itself reflects an appropriate level and a need
18 for testimony is not shown’”) (quoting *Litton Indus. Prods., Inc. v.*
19 *Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)).

20 *Facts Related To Secondary Considerations*

21 14. The Appellants present two articles, a set of customer
22 testimonials, and an Examiner interview summary as evidence of
23 secondary considerations. The interview summary contains an
24 Examiner finding that Costin alone does not describe limitation

1 [3]. None of the remaining pieces of evidence make any
2 comparison between the results of the claimed invention and that
3 of Costin.

4 PRINCIPLES OF LAW

5 *Obviousness*

6 A claimed invention is unpatentable if the differences between it and
7 the prior art are “such that the subject matter as a whole would have been
8 obvious at the time the invention was made to a person having ordinary skill
9 in the art.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007); *Graham*
10 *v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

11 In *Graham*, the Court held that that the obviousness analysis is
12 bottomed on several basic factual inquiries: “[1] the scope and content of
13 the prior art are to be determined; [(2)] differences between the prior art and
14 the claims at issue are to be ascertained; and [(3)] the level of ordinary skill
15 in the pertinent art resolved.” *Graham*, 383 U.S. at 17. *See also, KSR*, 550
16 U.S. at 406. “The combination of familiar elements according to known
17 methods is likely to be obvious when it does no more than yield predictable
18 results.” *KSR*, 550 U.S. at 416.

19 ANALYSIS

20 *Claims 58-72, 75-81, 82-94, 97-101, 102, and 106-107 rejected under 35*
21 *U.S.C. § 103(a) as unpatentable over Costin, McBrearty, Smith, and Gale*
22 *Group or Leukaemia Busters.*

23 The Examiner found that Costin described all the limitations of claim 58
24 except for a personal web page, a virtual plaque and the use of teams. The

1 Examiner found that McBrearty suggested the use of a personal web page,
2 Smith suggested a virtual plaque and that each of Gale Group and
3 Leukaemia Busters described the use of teams. Ans. 4-13.

4 The Appellants argue that none of the references describe or suggest
5 using a personal donation page. App. Br. 8-9. The Appellants also
6 submitted two articles, a set of customer testimonials, and an Examiner
7 interview summary as evidence of secondary considerations.

8 We agree with the Examiner that Costin describes limitations [1], [2],
9 and [3] except for using a personal web page as a donation page. Costin
10 describes hosting a web site with links to pages and providing information
11 about a fundraising campaign. FF 06. Costin describes having individuals
12 send emails to potential donors, where the emails have links to a donation
13 page. FF 04. Costin describes receiving a contribution via the donations
14 page. FF 04. Smith describes posting information about goals and actual
15 donations as in limitation [4] and both Gale Group and Leukaemia Busters
16 describe the use of teams in fundraising as in limitations [5] and [6]. Thus
17 the issue remaining is that raised by the Appellants of whether it would have
18 been obvious to use a personal web page for the donations page in Costin.

19 First we find that the only distinction between the personal donations
20 page as claimed and the donations page in Costin is the content of the web
21 page. That is, the only distinction is in the text, graphics, or multimedia
22 contents that are used to elicit a donation. There is no functional distinction
23 between the claimed personal web page and Costin's donation page. In light
24 of that, McBrearty's description of personalization as a key concept in
25 getting donations (FF 08) would have suggested to one of ordinary skill in

1 the fundraising arts to personalize solicitations wherever practical. Such a
2 suggestion as applied to Costin would have directly led to personalizing the
3 donation page as found by the Examiner. Thus, we find the arguments by
4 the Appellants unpersuasive.

5 As to the evidence proffered of commercial success, while they tend to
6 show that the general techniques used by the Appellants were superior to
7 non-internet based methods, the evidence does not recite the particular
8 techniques employed that resulted in the laudatory comments for comparison
9 with the claimed steps and more critically, does not show any comparison to
10 the closest prior art such as that in Costin. Thus, the articles do not provide
11 evidence to overcome the conclusion of obviousness based on the closest
12 prior art.

13 *Claims 75 and 97*

14 Claims 75 and 97 depend from cancelled claims and so the scope of
15 these claims is indeterminate. As a procedural matter, we reverse the
16 rejection of claims 75 and 97 under § 103. A rejection of a claim, which is
17 so indefinite that “considerable speculation as to meaning of the terms
18 employed and assumptions as to the scope of such claims” is needed, is
19 likely imprudent. *See In re Steele*, 305 F.2d 859, 862 (CCPA 1962)
20 (holding that the examiner and the board were wrong in relying on what at
21 best were speculative assumptions as to the meaning of the claims and
22 basing a rejection under 35 U.S.C. § 103 thereon.)

23 We find it imprudent to speculate as to the scope of claims 75 and 97 in
24 order to reach a decision on the obviousness of the claimed subject matter
25 under § 103. It should be understood, however, that our reversal is based on

1 the indefiniteness of the claimed subject matter and does not reflect on the
2 merits of the underlying rejection.

3 *Claims 58-72, 75-94, and 97-107 provisionally rejected under obvious*
4 *double patenting.*

5 The Appellants do not argue this rejection, but instead agree to file a
6 terminal disclaimer at the time of allowance, which would obviate this
7 rejection. App. Br. 18.

8 As with the obviousness rejection, *supra*, claims 75 and 97 depend from
9 cancelled claims and so the scope of these claims is indeterminate. As a
10 procedural matter, we reverse the rejection of claims 75 and 97 under the
11 doctrine of obviousness-type double patenting for reasons similar to those
12 we found in the obviousness rejection analysis. It should be understood,
13 however, that our reversal is based on the indefiniteness of the claimed
14 subject matter and does not reflect on the merits of the underlying rejection.

15 NEW GROUND OF REJECTION

16 The following new ground of rejection is entered pursuant to 37 C.F.R. §
17 41.50(b). Claims 75 and 97 are rejected under 35 U.S.C. § 112, second
18 paragraph, as failing to particularly point out and distinctly claim the
19 invention.

20 The test for definiteness under 35 U.S.C. § 112, second paragraph, is
21 whether “those skilled in the art would understand what is claimed when the
22 claim is read in light of the specification.” *Orthokinetics, Inc. v. Safety*
23 *Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986) (citations
24 omitted).

1 Each of these claims is written in dependent form incorporating the
2 subject matter of a cancelled parent claim. Claim 75 incorporates limitations
3 from cancelled claim 73. Claim 97 incorporates limitations from cancelled
4 claim 95. As cancelled claims are non-existent from the standpoint of the
5 record, any such limitations are necessarily indeterminate. Thus, we enter a
6 new ground of rejection of claims 75 and 97 under 35 U.S.C. § 112, second
7 paragraph, as being indefinite for failing to particularly point out and
8 distinctly claim what Appellants' intend as their invention.

CONCLUSIONS OF LAW

10 The Appellants have not sustained their burden of showing that the
11 Examiner erred in rejecting claims 58-72, 76-81, 82-94, 98, 100, 101, 102,
12 and 106-107 under 35 U.S.C. § 103(a) as unpatentable over Costin,
13 McBrearty, Smith, and Gale Group or Leukaemia Busters.

14 We reverse the rejection of claims 75 and 97 under 35 U.S.C. § 103(a) as
15 unpatentable over Costin, McBrearty, Smith, and Gale Group or Leukaemia
16 Busters because the claims are indeterminate and their scope is unknown.

17 The Appellants have not sustained their burden of showing that the
18 Examiner erred in provisionally rejecting claims 58-72, 76-94, and 98-107
19 under the doctrine of obviousness-type double patenting.

20 We reverse the rejection of claims 75 and 97 under the doctrine of
21 obviousness-type double patenting because the claims are indeterminate and
22 their scope is unknown.

23 The Appellants did not appeal the following rejections. These claims are
24 among those appealed in the provisional obviousness double patenting

1 rejection. These rejections remain and we accordingly summarily affirm
2 them.

3 Claim 103 under 35 U.S.C. § 103(a) as unpatentable over Costin and
4 McBrearty.

5 Claim 104 under 35 U.S.C. § 103(a) as unpatentable over Costin,
6 McBrearty, and Smith

7 Claim 105 under 35 U.S.C. § 103(a) as unpatentable over Costin,
8 McBrearty, Smith, and Gale Group or Leukaemia Busters

9 A new ground of rejection is entered pursuant to 37 C.F.R. § 41.50(b).
10 Claims 75 and 97 are rejected under 35 U.S.C. § 112, second paragraph, as
11 failing to particularly point out and distinctly claim the invention.

12 DECISION

13 To summarize, our decision is as follows.

- 14 • The rejection of claims 58-72, 76-81, 82-94, 98, 100, 101, 102, and
15 106-107 under 35 U.S.C. § 103(a) as unpatentable over Costin,
16 McBrearty, Smith, and Gale Group or Leukaemia Busters is sustained.
- 17 • The rejection of claims 75 and 97 under 35 U.S.C. § 103(a) as
18 unpatentable over Costin, McBrearty, Smith, and Gale Group or
19 Leukaemia Busters is not sustained.
- 20 • The provisional rejection of claims 58-72, 76-94, and 98-107 under
21 the doctrine of obviousness-type double patenting is sustained.
- 22 • The provisional rejection of claims 75 and 97 under the doctrine of
23 obviousness-type double patenting is not sustained.

1 • The Appellants did not appeal the following rejections, and so they
2 are summarily affirmed.

3 ○ Claim 103 under 35 U.S.C. § 103(a) as unpatentable over
4 Costin and McBrearty.

5 ○ Claim 104 under 35 U.S.C. § 103(a) as unpatentable over
6 Costin, McBrearty, and Smith

7 ○ Claim 105 under 35 U.S.C. § 103(a) as unpatentable over
8 Costin, McBrearty, Smith, and Gale Group or Leukaemia
9 Busters

10 • A new ground of rejection is entered pursuant to 37 C.F.R. § 41.50(b).

11 ○ Claims 75 and 97 are rejected under 35 U.S.C. § 112, second
12 paragraph, as failing to particularly point out and distinctly
13 claim the invention.

14 Regarding the affirmed rejection(s), 37 C.F.R. § 41.52(a)(1) provides
15 “Appellant may file a single request for rehearing within two months from
16 the date of the original decision of the Board.”

17 In addition to affirming the Examiner's rejection(s) of one or more
18 claims, this decision contains new grounds of rejection pursuant to 37 C.F.R.
19 § 41.50(b) (2007). 37 C.F.R. § 41.50(b) provides “[a] new ground of
20 rejection pursuant to this paragraph shall not be considered final for judicial
21 review.”

22 37 C.F.R. § 41.50(b) also provides that Appellant, WITHIN TWO
23 MONTHS FROM THE DATE OF THE DECISION, must exercise one of

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1 the following two options with respect to the new grounds of rejection to
2 avoid termination of the appeal as to the rejected claims:

3 (1) Reopen prosecution. Submit an appropriate amendment of
4 the claims so rejected or new evidence relating to the claims so
5 rejected, or both, and have the matter reconsidered by the
6 Examiner, in which event the proceeding will be remanded to
7 the Examiner. . . .

8 (2) Request rehearing. Request that the proceeding be reheard
9 under § 41.52 by the Board upon the same record. . . .

10 Should Appellants elect to prosecute further before the Examiner
11 pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek
12 review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection,
13 the effective date of the affirmation is deferred until conclusion of the
14 prosecution before the Examiner unless, as a mere incident to the limited
15 prosecution, the affirmed rejection is overcome.

16 If Appellants elect prosecution before the Examiner and this does not
17 result in allowance of the application, abandonment or a second appeal, this
18 case should be returned to the Board of Patent Appeals and Interferences for
19 final action on the affirmed rejection, including any timely request for
20 rehearing thereof.

21 No time period for taking any subsequent action in connection with this
22 appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

23
24 AFFIRMED

25 41.50(b)
26
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Appeal 2009-003994
Application 09/764,787

1 mev

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